

PATENT

Atty. Docket No. 10010317-1

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/Joseph G. Swan/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

MEHMET SAYAL, ET AL.

Serial No.: 10/066,238

Filed: January 30, 2002

For: TRADING PARTNER CONVERSATION
MANAGEMENT METHOD AND SYSTEM

Group Art Unit: 3693

Examiner: Jocelyn Greimel

Conf. No.: 2777

REQUEST TO RECONSIDER PETITION

Applicants hereby request reconsideration of the Petition to Technology Center Director under MPEP § 1002.02(c), filed on May 15, 2008, in the above-referenced application. In that Petition, Applicants requested acknowledgment that a sufficient showing had been made to swear behind U.S. Patent 7,043,687 (Knauss), thereby requiring the withdrawal of Knauss as a prior-art reference. The Petition was denied in a Decision mailed on June 4, 2008.

However, rather than addressing the substantive merits of Applicants' remarks pertaining to the propriety of swearing behind Knauss's actual filing date, the Decision instead just noted that Knauss claims the benefit of provisional application 60/257,980 filed on December 27,

2000, and then apparently based its denial of Applicants' Petition solely on the observation that "there is no evidence which shows conception prior to December 27, 2000, the effective filing date of Knauss." This ground for denying Applicants' Petition is believed to be inappropriate for the following reasons.

MPEP § 901.04 states:

"The 35 U.S.C. 102(e) date of a U.S. patent can be an earlier effective U.S. filing date. For example, the 35 U.S.C. 102(e) prior art date of a U.S. patent issued from a nonprovisional application claiming the benefit of a prior provisional application (35 U.S.C. 111(b)) is the filing date of the provisional application *for subject matter that is disclosed in the provisional application.*" [Emphasis added]

In the present case, the Decision apparently has concluded that the § 102(e) date for the entire disclosure of Knauss's issued patent is December 27, 2000 (the filing date of the provisional application), without any showing that any of the relevant subject matter actually was disclosed in Knauss's provisional application.¹

As noted in the Decision, in denying Applicants' request to swear behind Knauss, the Examiner made the following side comment:

"Additionally, the Examiner could rely upon and reference the Knauss provisional application filed 2 December 2000 (provisional application: 60/257,980)."

However, this side comment is completely irrelevant to the present issue. That is, the extent to which the Examiner potentially could have relied on Knauss's provisional application is not at issue here, given that the Examiner has not pointed to anything in Knauss's provisional application in support of the present rejection.

In addition, Applicants note that even the Examiner has not indicated any specific purpose for which Knauss's provisional application even arguably could be referenced, or any

¹ It is noted that the effective filing date of Knauss's issued *claims*, as is addressed by the portion of MPEP § 706.02 V cited in the Decision, is a different issue than the determination of the appropriate § 102(e) date for particular disclosures within Knauss's issued patent.

extent to which it arguably could be relied upon. Thus, it is impossible to know even the degree of relevance the Examiner attributes to Knauss's provisional application. In other words, the Examiner's statement regarding Knauss's provisional application has no meaning other than to indicate a possible course of action that the Examiner could have tried to pursue.

As is readily apparent, Knauss's provisional application is vastly different and far less extensive than Knauss's issued patent. For example, Knauss's provisional application contains 5 figures (plus 1 prior-art drawing) while Knauss's issued patent contains 26 figures. In addition, based on Applicants' word count estimate, Knauss's provisional application contains less than 1/10 of the total amount of text that is contained in Knauss's issued patent (approximately 1,700 words as compared to approximately 18,000 words of substantive text in the issued patent).

Accordingly, there simply is no basis for automatically concluding that the entire disclosure of Knauss's issued patent is entitled to a § 102(e) date of December 27, 2000. More specifically, Applicants are unable to find the subject disclosure (i.e., the disclosure relied upon by the Examiner in Knauss's issued patent) within Knauss's provisional application and, as noted above, the Examiner has not even attempted to argue that any of such disclosure is present within Knauss's provisional application. In short, the Examiner's simple conclusory statement that the Examiner could have relied upon and/or referenced Knauss's provisional application is irrelevant and utterly meaningless.

For all of the foregoing reasons, Applicants respectfully request reconsideration of the Petition filed on May 15, 2008.

If there are any fees due in connection with the filing of the currently submitted papers that have not been accounted for in this paper or the accompanying papers, please charge the fees to Deposit Account No. 08-2025. If an extension of time under 37 C.F.R. 1.136 is required for the filing of any of the currently submitted papers and is not accounted for in this paper or the accompanying papers, such an extension is requested and the fee (or any underpayment thereof) should also be charged to the Deposit Account.

Dated: June 19, 2008

Respectfully submitted,
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